



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/577,078	05/23/2000	Toshihiro Shima	04783.012001	4163

22511 7590 11/09/2006

OSHA LIANG L.L.P.  
1221 MCKINNEY STREET  
SUITE 2800  
HOUSTON, TX 77010

EXAMINER

SCHLACK, SCOTT A

ART UNIT

PAPER NUMBER

2625

DATE MAILED: 11/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/577,078

Applicant(s)

SHIMA, TOSHIHIRO

Examiner

Scott A. Schlack

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-4, 6-10, 13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 13 and 14 is/are allowed.
- 6) ☒ Claim(s) 2-4 and 6-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 May 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/18/2006 has been entered.

#### ***Response to Amendment***

2. Applicant's amendment was received on 09/18/2006, and has been entered and made of record. Currently, claims **2-4** and **6-10** are pending and claims and **13-14** are allowed.

#### ***Response to Arguments***

3. Applicant's arguments have been fully considered but they are not persuasive.

4. With respect to independent claims **2, 4, 6-10** and dependent claim **3**, the applicant argues that the newly amended claimed features are not met by the 35 U.S.C. 102(e) rejection of Gase (US 6,184,996). The applicant is reminded that according to chapter 2100 of the MPEP (2111 [R-1]), Claim Interpretation; Claims must be given their broadest reasonable interpretation.

5. The applicant asserts that: (i) Gase does not teach the claimed feature of the printer directing the peripheral device to capture data. (ii) *after* receiving the data, the printer performs printing. The examiner notes to the applicant that argued feature (iii) is not a claimed feature, and is therefore not addressing this argument as such. Regarding this

Art Unit: 2625

issue, the examiner suggests that the applicant amend the claims to contain the argued features, if they view them to read over the Gase reference.

**Examiners Response:** The examiner notes the claim language as amended, which the applicant argues, in regards to item (i), "the printer, upon receiving the new print request, directs the peripheral device to capture the data". Gase discloses a Browser Procedure (col 3, lines 16-36), wherein a client processor (Computers 10 and 12 of Fig 1) submits a print request (URL designating print job) to the printer (Printer 14 of Fig 1). The URL is then listed in the printer's print queue. Further, the examiner notes that the URL may designate a print job residing on a client, which is not the originating client (peripheral device). When the URL (print request) is reached in the queue, the printer causes the browser to transmit a request to the client processor where the URL is located (notably other than the originating device). The client then responds to the request by transmitting the print job to the printer (col 3, lines 16-36). The examiner interprets the process of the peripheral (client device other than the originating client device where data is stored) accessing data from its own memory for transfer to the printer, to be equivalent to capturing data. The examiner also views this data capture to be directed by the printer. The examiner again notes that several of the other features the applicant argues are not specifically stated in the claim language (they cannot be inferred, the examiner must take the broadest reasonable interpretation of the claim language). If the applicant wishes the examiner to consider these other features they need to be part of the claimed invention (i.e. ordering of data capturing (before, after,

Art Unit: 2625

simultaneously) data in relation to other claimed features and the location where data is captured from).

The examiner notes the claim language as amended, which the applicant argues, in regards to item (ii) wherein the printer, upon receiving the new print request, directs the peripheral device to capture the data, and wherein the peripheral device sends the data captured in response to the request from the printer, to the printer for printing.

The applicant argues that “the data is not captured prior to the printer request, but rather, the data is captured afterwards”.

**Examiner's Response:** The examiner has interpreted the process of the peripheral (client device other than the originating client device where data is stored) accessing data from its own memory for transfer to the printer, to be equivalent to capturing data. The examiner also views this data capture to be directed by the printer. Therefore, the data is not captured prior to the printer request, but rather it is captured afterwards. The examiner notes to the applicant that the word capture can be broadly interpreted, and therefore suggest that they rephrase their claims to specify the features they argue as not being met by Gase.

### ***Claim Objections***

6. Claim 2 is objected to because of the following informalities: The printer is said to comprise: a program “wherein according to the program, the processor (the printer's processor): receives from a client computer a new print request...” and the printer's processor later in the claim “sends the new print request to the printer”. The examiner notes this is not possible. The printer already has received the print request originating

Art Unit: 2625

from the client. How or why would the printer then send the print request to itself? There is only one printer ("the printer") claimed. The examiner views this to be an error and recommends that the applicant remove the claimed feature of the printer processor sending the new print request to the printer. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims **2-4**, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the examiner notes that applicant refers to "the printer" and "a printer" in the claim language as if it were a second printer, when the applicant hasn't specifically claimed a "second printer". If the applicant has not intended for these terms to infer a second printer, then the claims need to be rewritten to distinctly claim the applicant's invention. If the applicant has intended for these terms to refer to a second printer, then there is insufficient antecedent basis for this limitation in the claim, as a second printer has not specifically been claimed. The examiner notes that claims **13** and **14**, do claim a first and second printer and therefore suggests that the applicant follow this format in claiming their invention.

***Claim Rejections - 35 USC § 101***

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Art Unit: 2625

10. Claim 7 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

11. Regarding claim 7, the phrase "a program product" does not explicitly identify a physical "thing". Programs are neither computer components nor statutory processes, as they are not "acts" being performed. Therefore, the examiner recommends that claim 7 be withdrawn or that the phrase, "a program product" be changed to "a computer-readable medium comprising a program product". These revisions are necessary for the claims to be considered.

### ***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 2-4 and 6-10 rejected under 35 U.S.C. 102(e) as being anticipated by Gase (US 6,184,996).

14. See the Non-Final office action dated 12/12/2005, by Primary Examiner Mark E. Wallerson. The examiner notes that the amended features to independent claims 2, 4 and 6-10, are all similar in content and covered by the Gase reference. See the Response to arguments section above.


### ***Conclusion***

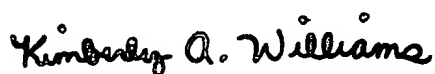
Art Unit: 2625

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott A. Schlack whose telephone number is (571)272-7954. The examiner can normally be reached on 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on (571)272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Scott A. Schlack



KIMBERLY WILLIAMS  
SUPERVISORY PATENT EXAMINER